

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1, 2, 5-33, and 36-59 are all the claims pending in the application. Applicant respectfully submits that the pending claims define patentable subject matter.

In response to the Amendment filed November 14, 2006, the Examiner has withdrawn the previous grounds of rejection, and now rejects claims 1, 2, 5-33 and 36-59 under 35 U.S.C. § 103(a) as being unpatentable over Ludwig et al. (U.S. Patent No. 6,697,352 B1; hereinafter “Ludwig”) in view of newly cited Yi et al. (U.S. Patent App. Pub. No. 2002/0001314; hereinafter “Yi”) and Zhu (U.S. Patent No. 6,154,780). Applicant respectfully submits the rejection is improper.

In particular, Applicant submits the newly cited Yi reference does not qualify as prior art under 35 U.S.C. § 102, since the filing date of the present application, January 2, 2001 is prior to the filing date of Yi, June 11, 2001. Further, Yi claims priority from KPA 2000-36514, which was published January 9, 2002, which is also after the January 2, 2001 filing date of the present application. Therefore, Yi does not qualify as prior art under 35 U.S.C. § 102. Accordingly, the Examiner is requested to remove the § 103 rejection.

Additionally, the Examiner now rejects all of the claims under 35 U.S.C. § 101, as allegedly being directed to non-patentable subject matter. Specifically, regarding independent claims 32 and 33, the Examiner asserts that since page 14, lines 5-11 of the specification states that the computer-readable medium can include a carrier wave, the claimed embodiment is non-statutory under 35 U.S.C. § 101.

Applicant herein amends the specification and claims 32 and 33, and submits that the informalities noted by the Examiner are obviated by the amendment made herein.

Regarding the rejection of independent claims 1 and 2 under 35 U.S.C. § 101, the Examiner argues that “as evidenced in claims 32, 33, claims 1-28 are claiming software in the form of method.” The Examiner further states that

[t]he final result achieved by claim 1 is to provide a service protocol responsive to receiving a request identifying a value added service protocol. It is clear that 1) there is no physical transformation recited in the claim, and 2) no useful and tangible result recited in the claim.

Applicant respectfully disagrees with the Examiner’s position.

Applicant submits that independent claims 32 and 33 have no bearing on whether claim 1 is a computer program. Further, the fact that claim 1 may be performed by computer does not necessarily mean that claim 1 is directed to only a software program or an abstract idea. On the contrary, Applicant points out independent claims 1 and 2 are method claims which require the physical transforming acts of coding, adding and transmitting. Moreover, Applicant submits that the claims recite a useful and tangible result, e.g., transmitting.

Furthermore, the Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility state:

35 U.S.C. Sec. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. The latter three categories define “things” or “products” while the first category defines “actions” (i.e., inventions that

consist of a series of steps or acts to be performed).... The term 'process' means process, art, or method.¹

Since claims 1 and 2 are method claims, Applicant submits they fall within the statutorily patentable categories noted above. Moreover, Applicant submits claims 1 and 2 are not merely abstract ideas since, as noted above, they require the physical transforming acts, such as coding, adding and transmitting. Therefore, Applicant submits that independent claims 1 and 2 are statutorily patentable under 35 U.S.C. § 101, for at least these reasons.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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¹ See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility at paragraph bridging pages 12 and 13 (OG Notice, November 22, 2005) (emphasis added).